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AUG 23 2004

In re Application of
Mead, et al.
Application No. 10/661,036
Filed: 12 September, 2003
Attorney Docket No. 112300-1409

OFFICE OF PETITIONS

DECISION ON PETITION

This is a decision on the petition filed (with fee) on 12 July, 2004, under the 37 C.F.R. §1.53 to accord to the instant application the filing date of 12 September, 2003, as originally accorded upon deposit.

The petition is **GRANTED**.

BACKGROUND

The application was deposited with the Office on 12 September, 2003.

On 26 January, 2004, the Office mailed a Filing Receipt reflecting a filing date of 12 September, 2003.

On 26 January, 2004, the Office also mailed a Notice of Missing Parts of a Nonprovisional Application (the Notice of Missing Parts), indicating, *inter alia*, that:

- a filing date had been granted the application;
- the signed oath/declaration was missing from the application;
- “Figure(s) 10 described in the specification” appeared to have been omitted from the application as deposited.

The Notice reminded Petitioner that the alternatives available with regard to omitted item under the Rules of Practice were to:

- submit a petition (with fee) with evidence of actual deposit of the Figure 10 at the time the application was deposited with the Office; or
- submit the omitted Figure 10 and accept the date of that submission as the filing date of the application.

On 23 February, 2004, Petitioner responded to the Notice of Missing Parts with the oath/declaration and appropriate fees. Petitioner did not include a copy of or take any other action with regard to the omitted item Figure 10.

On 15 March, 2004, the Office mailed a Notice of Omitted Items in a Nonprovisional Application (the Notice of Omitted Items), indicating, *inter alia*, that:

- a filing date had been granted to the application;
- however, “Figure(s) 10 described in the specification” appeared to have been omitted from the application as deposited.

The Notice reminded Petitioner that the alternatives available with regard to omitted items under the Rules of Practice were to:

- submit a petition (with fee) with evidence of actual deposit of the Figure 10 at the time the application was deposited with the Office;
- submit the omitted Figure 10 and accept the date of that submission as the filing date of the application; or
- not file a petition or submit the omitted Figure 10.

On 15 March, 2004, the Office also mailed an “Updated” Filing Receipt reflecting a filing date of 23 February, 2004.

Petitioner supplemented the instant 12 July, 2004, petition with a date-stamped receipt card (see: MPEP §503¹) and copy of the original filing receipt.

¹ MPEP §503 provides in pertinent part:
§503 Application Number and Filing Receipt

* * *

A return postcard should be attached to *each* patent application for which a receipt is desired. It is important that the return postcard itemize all of the components of the application. If the postcard does not itemize each of the components of the application, it will not serve as

ANALYSIS

A review of the application papers reveals that the application was filed and received in the Office on 12 September, 2003, and that at the filing Figure 10 was missing from the application.

Further review of the application reveals that Petitioner neither sought to obtain a 12 September, 2003, filing date for Figure 10, nor submitted a copy of Figure 10 by which to accept the receipt date of such submission as a later filing date than that of 12 September, 2003, as originally accorded. Thus, the change in the filing date by the Office was made in error, as was the mailing by the Office of the "Updated" Filing Receipt.

Therefore, the change in filing date and the 15 March, 2004, issuance of an "Updated" Filing Receipt are vacated, and the originally accorded filing date of 12 September, 2003, is reinstated.

CONCLUSION

Accordingly, the petition under 37 C.F.R. §1.53 is granted, and no petition fee is charged. The instant file is released to OIPE for action in accordance with this decision to:

evidence that any component which was not itemized was received by the United States Patent and Trademark Office (USPTO). It should be recognized that the identification of an application by application number does not necessarily signify that the USPTO has accepted the application as complete (37 C.F.R. §1.53(a)).

* * *

RETURN POSTCARD

If a receipt of any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item. The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

The identifying data on the postcard should be so complete as to clearly identify the item for which receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., and the number of pages being submitted. If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application).

The postcard receipt will not serve as *prima facie* evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as *prima facie* evidence of receipt of those items.

The person receiving the item(s) in the USPTO will check the listing on the postcard against the item(s) being filed to be sure they are properly identified and that all the items listed on the postcard are presently being submitted to the USPTO. If any of the items listed on the postcard are not being submitted to the USPTO, those items will be crossed off and the postcard initialed by the person receiving the items. Upon return of a postcard receipt from the USPTO, the postcard receipt should be promptly reviewed by the person who filed the items to ensure that every item specifically denoted on the postcard was received by the USPTO. If the postcard receipt has been annotated to indicate that a particular item denoted on the postcard was not received by the USPTO, the postcard receipt will not serve as *prima facie* evidence of receipt of that item in the USPTO. (Emphasis supplied.)

- correct Office records to reflect that a filing date of 12 September, 2003, is accorded to the instant application as deposited on that date without Figure 10; and
- a corrected filing receipt is issued setting forth the filing date of 12 September, 2003.

In order to advance prudently the prosecution of the instant matter, Petitioner may wish to file a preliminary amendment deleting reference(s) to Figure 10 and request entry of the amendment by the Examiner.

The application is released to OIPE for such processing as is necessary consistent with this decision. Thereafter the file will be forwarded to Technology Center 3700 for examination in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



John J. Gillon, Jr.
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Office of Petitions